

REMARKS

This paper is responsive to an Office Action mailed December 10, 2007. Prior to this response, claims 1, 3-4, 7-8, 10, 12-13, and 16-18 were pending. After amending claim 1, claims 1, 3-4, 7-8, 10, 12-13, and 16-18 remain pending.

In Section 6 of the Office Action, claims 1, 3-4, and 7-8 are objected to because of an informality. In response, claim 1 has been amended to place a comma, between the phrase “encrypting the scanned document” and “creating an encrypted document”.

In Section 9 of the Office Action claims 1, 3-4, 7-8, 10, 12-13, and 16-18 have been rejected under 35 U.S.C. 103(a) as being unpatentable with respect McGraw (US 6,542,261) in view of Chan et al. (“Chan”; US 6,378,070). With respect to claims 1 and 10, the Office Action acknowledges that McGraw fails to compare an access code to a password in the file, but that Chan discloses this feature, and that it would have been obvious to incorporate Chan’s features into McGraw, since a document is only printed when the intended recipient interacts with the printing apparatus. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggest 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that Chan suggests modifications to McGraw that would have been obvious to one of ordinary skill in the art. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to the G) rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

McGraw describes a system that transmits an encrypted fax document with an unencrypted heading, indicating the intended recipient (col. 3, ln. 1-30). The fax message, in either paper or electronic form, is converted into a graphics (scan) document. Typically, the encrypted fax paper document is scanned, and secure fax driver software decrypts the document (col. 4, ln. 9-31). In one aspect, a computer employees a custom “fax card” to streamline the process (col. 4, ln. 37-49).

The fax document can be encrypted using a number of well-known technologies (col. 4, ln. 30). However, McGraw does not transmit a password with the encrypted document. The user must select a code at the transmit side, but the code is not sent with the document (col. 6, ln. 17-34). The recipient must present a “decode code”, but this code is *not* something that the user recovers from the received document (col. 6, ln. 38-62).

The secure FAX document includes an unencrypted header at the top of the page that identifies the receiving party and the sending party (Fig. 4). McGraw’s FAX does *not* include an unencrypted header that identifies an encrypted document, the header is merely printed on the same page as encrypted fax. Alternately stated, the identification of the sender and recipient is not the identification of an encrypted document. Further, the

Applicant's recited file header, an electronic medium, can be clearly distinguished from McGraw's printed header on a paper medium.

Chan discloses a method of securely transmitting a document so that only the intended recipient can receive it. More explicitly, Chan describes a process where the sender stores a document and a first identifier at a print server. The recipient sends a second identifier from the printer to the print server. The print server compares the first identifier to the second identifier. If the identifiers match, the server sends the document to the printer. In other words, the security process (the identification of the recipient) is carried out at a device (server) external to the printer.

With respect to the Applicant's claim 1 and the first analysis criteria to support a rejection under the G) rationale, the Applicant respectfully submits that a person of ordinary skill in the art would be unlikely to combine the McGraw and Chan references. As noted above, McGraw's security procedures are enacted on the receiving side. After the fax is received, the user must present a code before the document is released. Chan's process is conceptually different, as the security procedures are enacted on the sending side. The print server does not send the document to the printer until the server is able to identify the recipient. Therefore, the Chan invention teaches away from the McGraw invention.

Further, even if a person of ordinary skill would have modified McGraw in view of Chan, the combination of references fails to describe all the limitations of claims 1 and 10. Neither McGraw nor Chan disclose the transmission of a password, or the transmission of a password with an encrypted document. Neither McGraw nor Chan disclose the transmission of a document with an unencrypted identification of the encrypted document.

Finally, neither reference discloses the transmission of a password in a file header.

Neither has evidence been provided that it would have been generally known at the time of the invention to add or combine all the above-mentioned claim limitations missing in the McGraw and Chan references. Therefore, what was known in the art at the time of the invention cannot suggest modifications to McGraw that would make obvious the limitations of transmitting a password in the file header of an encrypted document, or transmitting an unencrypted identification of the encrypted document. Claims 3-4 and 7-8, dependent from claim 1, and claims 12-13 and 16-18, dependent from claim 10, enjoy the same distinctions from the prior art.

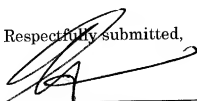
With respect to the second analysis criteria, the Office Action presents no finding that there was a reasonable expectation of success.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since McGraw does not explicitly disclose every limitation of claim 1. Neither has a case been supported that the McGraw reference can be modified to supply the missing limitations in view of Chan, or what was known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 1, 3-4, 7-8, 10, 12-13, and 16-18 be withdrawn.

Applicant asserts that the claims are patentable over the references made of record. It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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Gerald Maliszewski
Registration No. 38,054

Customer Number 55,286
P.O. Box 270829
San Diego, CA 92198-2829
Telephone: (858) 451-9950
Facsimile: (858) 451-9869
gerry@ipatentit.net